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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,691	11/10/2003	Jenn S. Shih	FDN-2737	5236

7590 11/28/2005

## INTERNATIONAL SPECIALTY PRODUCTS

Attn: William J. Davis, Esq.  
Legal Department, Building No. 10  
1361 Alps Road  
Wayne, NJ 07470

EXAMINER
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EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/705,691

Applicant(s)

SHIH, JENN S.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,13-21,24,25 and 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-12,22,23 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, 20-23 and 26-29, drawn to an interpolymeric carrier concentrate, classified in class 523, subclass 351.
  - II. Claims 13-19, 30 and 32-34, drawn to the process of producing the carrier of claim 1, classified in class 523, subclass 351.
  - III. Claims 24 and 25, drawn to an emulsion prepared from the interpolymeric carrier concentrate of group I, classified in class 424, subclass 78.02.
  - IV. Claims 31 and 35, drawn to a process for using the product of group I to prepare the product of Group III, classified in class 424, subclass 78.02.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process, for instance, wherein the network polymer is not polymerized in the presence of the oil or wherein the process does not involve cooling, and process as claimed can be used to make other and materially different product wherein the entrapped polymer is a dispersed water-soluble polymer.

3. Inventions II and IV are related as process of making and process of using the product. Since the product is not allowable, restriction is proper between said method of making and method of using. (MPEP § 806.05(i)).

4. Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an additive control composition and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used as an additive control composition.

6. Inventions II and III are unrelated. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

7. Because these inventions are distinct for the reasons given above and the search required for some of the Groups is not required for the rest, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. This application contains claims directed to the following patentably distinct species of two separate genii of the invention of Group I.

A) For the first genus of Group I

a. wherein the crosslinked polymer is a polymer derived from a vinyl pyrrolidone and acrylic acid. (claim 2)

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b. wherein the crosslinked polymer is a polymer derived from C<sub>1</sub> to C<sub>30</sub> alkyl acrylates. (claim 3)

c. wherein the crosslinked polymer is a polymer derived from a monomeric mixture of a vinyl lactam and acrylic acid or a mixture of C<sub>1</sub> to C<sub>30</sub> alkyl acrylates. (claims 20 and 21)

B) For the second genus of Group I:

a. wherein the oil soluble polymer is a polymer derived from a vinyl pyrrolidone and acrylic acid. (claim 4)

b. wherein the oil soluble polymer is a polymer derived from C<sub>1</sub> to C<sub>30</sub> alkyl acrylates. (claim 5)

10. This application contains claims directed to the following patentably distinct species of two separate genii of the invention of Group II.

A) For the first genus of Group II

a. wherein individual initiators for monomers A and B are employed in the first and second stages of the process. (claim 15)

b. wherein the same initiator is employed for monomers A and B in the first and second stages of the process. (claim 16)

B) For the second genus of Group II:

- a. wherein the crosslinking agent for monomer B is the same as the crosslinking agent for monomer A. (claim 18)
- b. wherein the crosslinking agent for monomer B is different from the crosslinking agent of monomer A. (claim 19)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims in the elected group shall be restricted if no generic claim is finally held to be allowable. Currently, 1 is generic for group I and claim 13 is generic for group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with William J. Davis on 11/14/05, a provisional election was made with traverse to prosecute the invention of Group I, species Aa and Bb, claims 1, 2, 5-12, 22, 23 and 26-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4, 13-21, 24, 25 and 30-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

3. Claim 9 is objected to because of the following informalities: A word appears to be missing between "oil" and isocetyl". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 12, 23, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



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6. Claim 5 recites "wherein (b) is a polymeric mixture of C<sub>1</sub> to C<sub>30</sub> alkyl acrylates".

Since alkyl acrylates are not polymers, it is unclear what applicant is indenting to claim.

7. Claim 12 recites "[t]he carrier of claim 1 which optionally and additionally contains a surfactant and/or a dispersant". The phrase "**optionally** and **additionally**" renders the claim indefinite because it is unclear whether the components following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

8. Claim 23 recites the limitation "the first stage" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

9. Claims 28 and 29 recite the limitation "monomer A to monomer B" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 6-9, 12, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mooney et al. (USPN 5,814,031).

In col. 2, lines 22-25, col. 3, lines 16-35, col. 4, lines 11 to col. 6, line 20, Mooney et al. teach an interpolymetric composition comprising a non-volatile oil medium and about 0.5 to about 10% of an oil soluble flow control polymer physically entrapped in about 0.5 to about 10% of a network of a crosslinked polymer selected from polymers of a water-soluble monomers, such as acrylic acid, the percentage being based on the weight of the composition, said composition further comprising active components for skin care and/or therapeutic products.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 5, 10, 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney et al.

The species of genus is prima facie obvious. It is applicants burden under these to establish that species or sub-species of crosslinked acrylic polymer network and oil provides some unexpected results over the applied reference(s). See In re Woodroff, 16 USPQ2d 1934(Fed. Cir. 1990): In re Susi 169 USPQ 423 (CCPA 1971).

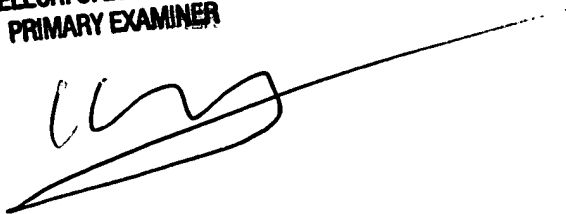
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

**KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'KE', is written over a horizontal line that extends to the right.